

REMARKS

The final Office Action dated January 16, 2007 has been reviewed, and the comments of the U.S. Patent Office have been considered. Claims 15-18, 20 and 21 stand rejected in view of U.S. Patent No. 5,776,162 to Kleshinski ("Kleshinski") and U.S. Patent No. 4,680,573 to Ciordinik et al. ("Ciordinik") as indicated at page 2 of the Detailed Action. Claims 1-14 have been canceled, claims 15 and 16 have been amended and claims 17-22 remain as previously presented. Accordingly, claims 15-22 are currently pending. Applicants submit that the amendments to the claims and the arguments presented below traverse the rejections and place the application in condition for allowance over the prior art of record and/or at least better form for appeal. As such, entry of the proposed amendment is respectfully requested.

Applicants thank the Examiner for participating in the March 26, 2007 telephonic interview with Applicant's representative as summarized in the Interview Summary issued on March 28, 2007. In accordance with MPEP 713.04, applicant's representative provides the following summary of the interview. Applicant appreciates the Examiner correcting the apparent typographical error in the Office Action Summary of the January 16 final Office Action indicating that claim 22 was rejected. Accordingly, applicants understand claim 22 as presented overcomes any prior rejections under 35 U.S.C. 112, second paragraph and is therefore allowable. Applicant also appreciates the Examiner discussing the rejected claims 15 and 16 in view of the applied prior art references: Kleshinski and Ciordinik. As indicted in the Interview Summary, it was understood by applicant's representative that recitation of a filter in the bodies of independent claims 1 and 16 would make the claims look more favorable in view of the applied references.

Claims 15, 20-21 stand rejected under 35 U.S.C. 102(b) as being anticipated by Kleshinski. According to the Examiner, Kleshinski shows or describes in its filter an essential element of a filter delivery unit as claimed. *See* Detailed Action at 3. The Examiner further argues that Kleshinski shows or describes a pusher wire, flexible hinge, and filter engaging pusher pad as claimed. *See id.* at 2

Applicants respectfully disagree and reiterate the remarks filed in the response dated November 1, 2006. In particular, applicants again submit that Kleshinski fails to show or describe a filter delivery unit for a vascular filter, or a filter delivery unit having the elongate pusher wire and flexible hinge, as recited in claim 15. Stated simply, Kleshinski shows and describes only a blood filter, and fails to show or describe a delivery unit for a blood filter. *See* Kleshinski at Abstract. Kleshinski's blood clot filter 10 is not a delivery unit for a filter. The only description provided in Kleshinski regarding a delivery unit is limited to non-specific references to catheters and plastic tubing. *See id.* at col. 1, lines 19-20 and 29-31, col. 2, line 53, and col. 3, lines 19-21.

Notwithstanding, in the interest of advancing prosecution toward allowance, applicants have amended independent claim 15 to recite a filter delivery system comprising, among other features, a vascular filter having a plurality of elongate appendages for engaging a vessel wall and a filter delivery unit for delivery of the filter including, an elongate pusher wire having a free end to engage a portion of the filter. Kleshinski is directed to a vessel implant and otherwise fails to show or describe a vascular filter and a filter delivery unit with all the features as claimed. Specifically, nowhere does Kleshinski show or describe a filter and a filter delivery unit including an elongate pusher wire having a free end to engage a portion of the filter.

Because Kleshinski fails to show each and every feature of the claimed filter delivery system, the rejection cannot stand. Withdrawal of the rejection is respectfully requested.

Claims 16-18 stand rejected under 35 U.S.C. 102(b) as being anticipated by Ciordinik. In response to applicant's prior arguments, the Examiner alleges that Ciordinik can read upon the claims of the instant application and therefore can be considered as capable of performing the same function as that of the claimed invention. *See* Detailed Action at 3. Moreover, the Examiner alleges that the wire of Ciordinik can be used in a filter delivery unit as claimed. *See* Detailed Action at 3.

Again, applicants respectfully disagree and reiterate its arguments in the response of November 1, 2006. In particular, Ciordinik fails to show or describe a filter delivery unit, or a filter delivery unit having an elongate pusher wire, a flexible hinge, and an enlarged spline, as recited in claim 16. Ciordinik is limited to a wire used in a wire fence. *See* Ciordinik at Abstract. Ciordinik's wire 1 is not a delivery unit for a filter, or part of a delivery unit for a filter. Accordingly, Ciordinik does not show or describe a filter delivery unit and the other features recited in claim 16. MPEP §2131 makes clear that "to anticipate a claim, the reference must teach every element of the claim."

In addition, applicants submit that Ciordinik is not an enabled reference so as to present a sufficient prior art disclosure to render the claimed invention as anticipated. To qualify as an anticipatory reference, the asserted prior art reference must "provide an enabling disclosure of the desired subject matter; mere naming or description of the subject matter is insufficient, if it cannot be produced without undue experimentation." *See* MPEP 2121.01.

A reference contains an "enabling disclosure" if the public was in possession of the claimed invention before the date of invention. "Such possession is effected if one of ordinary skill in the art could have combined the publication's description of the invention with his [or her] own knowledge to make the claimed invention."

Id. (quoting *In re Donohue*, 766 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985)). Applicants contend that given the disclosure of Ciordinik is directed to an intrusion warning wire fence, and therefore Ciordinik does not place the public in possession of the claimed filter delivery unit at least arguably not without undue experimentation. The examiner relies upon FIGS. 1 - 3 of Ciordinik in combination with the text at column 2, lines 58-62 as showing and describing the claimed elongate pusher wire and enlarged spline having an outer surface provided with a plurality of spaced grooves. *See* Detailed Action at 2. Applicant respectfully disagrees.

“Drawings and pictures can anticipate claims if they clearly show the structure which is claimed.” MPEP 2125 (citation omitted). “However, the picture must show all the claimed structural features and how they are put together.” *Id.* “The description of the article pictured can be relied on, in combination with the drawings, for what they would reasonably teach one of ordinary skill in the art.” *Id.* Applicants submit that the description in Ciordinik, with respect to FIGS. 1-3, would teach nothing to one of ordinary skill in the art of vascular filters and their delivery. Specifically, the grooves of Ciordinik, which the Examiner alleges to show or describe the claimed spline and grooves are specifically described as

[W]eakening notches or grooves 3, 4, 5 in which their number, depth, width and/or circumferential or longitudinal extension are selected as a function of the desired weakening effect on the tubular wire 1 so as to obtain an intrusion warning wire-lattice affording a predetermined overall mechanical strength, but at least some weakened tubular wires of the type described above will break more easily when individually subjected to a stress beyond a pre-established limit, and in particular when an intruder tries to climb on the fence to step thereover. When the weakened tubular wires 1 will be broken, the respective electrical and/or optical conductor(s) will also be broken or distorted, so as to produce an alarm indication at the warning indicator.

Ciordinik, col. 2, line 65 to col. 3, line 12. Nowhere is it taught or suggested in Ciordinik to form the notches or grooves 3, 4, 5 to receive appendages of a vascular filter. Accordingly,

nothing is shown or described in Ciordinik so as to teach or suggest to one of ordinary skill in the art the claimed filter delivery unit and thereby anticipate the filter delivery unit as claimed.

Notwithstanding, in the interest of advancing prosecution toward allowance, applicants have amended independent claim 16 to recite a filter delivery system comprising, among other features, a vascular filter having a plurality of elongate appendages for engaging a vessel wall and a filter delivery unit for delivery of the filter including, an elongate pusher wire having a free end to engage a portion of the filter. As detailed above, Ciordinik is directed to an intrusion warning wire fence. Accordingly, nowhere does Ciordinik show or describe a filter or a filter delivery unit as claimed. Because Ciordinik fails to show each and every feature of the claimed filter delivery system, the rejection cannot stand and claim 16 is therefore patentable. Withdrawal of the rejection is respectfully requested. Claims 17-19 depend from claim 16 and should be allowed for at least the same reasons.

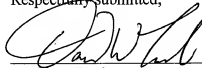
Contrary to the Office Action Summary, the Detailed Action does not indicate claim 19 as being rejected. Accordingly, applicants understand claim 19, as previously presented, has overcome all previous rejections under 35 USC 112, second paragraph, *see* Office Action of 8/8/06, and therefore at least, in itself, contains allowable subject matter.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this Application and the prompt allowance of at least claims 15-22. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact the undersigned to expedite prosecution of the application.

The Commissioner is hereby authorized by this paper to charge any fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 50-3840. **This paragraph is intended to be a CONSTRUCTIVE PETITION FOR EXTENSION OF TIME in accordance with 37 C.F.R. § 1.136(a)(3).**

Respectfully submitted,



David W. Laub
Attorney for Applicant
Reg. No.: 38,708

Date: April 10, 2007
Patent Administrator
Proskauer Rose LLP
1001 Pennsylvania Avenue, NW
Suite 400
Washington, DC 20004
Telephone: 202.416.6800
Facsimile: 202.416.6899
CUSTOMER NO: 61263

Customer No. 61263